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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,229	05/19/2000	Toru Chiba	P19101	7775

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 08/27/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,229

Applicant(s)

CHIBA, TORU

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 11, 2003 has been entered.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 30-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 30-32 recite a thickness of the resin molded surface layer ranging from approximately 0.2 mm to approximately 0.5 mm.

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There is no support in the originally filed disclosure for these limitations. The only reference to the thickness of the resin molded surface layer in the originally filed disclosure occurs in the examples described at pages 10-12 of the specification. In the first example, it is stated that the resin molded layer has a thickness of 0.5 mm (p. 11, line 3). In the second example, the thickness is said to be 0.2 mm (p. 12, line 3). There is no disclosure of the possibility of the thickness of the resin molded surface falling in the range between 0.2 mm to 0.5 mm. Further, there is no disclosure of the thickness being "approximately" 0.2 mm, or "approximately" 0.5 mm. Thus, the limitations of claims 30-32 contain new matter.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-5, 20-23, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Blum (U.S. Pat. No. 5,141,678; previously of record).

Blum discloses a lens molding die. A base member (10) of a hard material with one surface of a predetermined shape is provided. A resin-molded surface layer (12) formed on the surface of the base member has a surface shape corresponding to a predetermined shape of a surface of the lens to be produced. The surface shape of the resin-molded surface layer conforms (i.e., is similar to) but is not identical the shape of the base member surface (see figure 1).

Blum further discloses the resin molded surface layer to be made from a thermosetting resin, or alternatively, an ultraviolet curable resin material (column 3, lines 41-43 and column 4, lines 4-13).

Blum further discloses, in the embodiment shown in figure 1, the base member to comprise a spherical surface, and the molded surface layer to be aspheric. The molded surface layer is aspheric as a result of the notch formed at the central portion of the molded surface layer (see figure 1). To the left and right of the aspheric notch, the thickness of the resin-molded surface layer is constant. Thus, the thickness of the resin-

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molded surface layer is configured to vary only in accordance with the aspheric component of the resin molded surface layer.

Note, although figure 1 of Blum shows the base member (10) separated after the molded surface layer (12) is formed, Blum discloses that the base member "can be made of any material, including materials which will bond with the monomer material used to form the resulting mold" (column 2, lines 58-60).

6. Claims 1, 21, 24-25, and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishihara et al. (U.S. Pat. No. 6,315,929; previously or record).

Ishihara discloses a lens molding die. A base member (8) of a hard material is provided having one surface (9) of a predetermined shape. A molded surface layer (10) is formed on one surface of the base layer (see figure 2). The surface layer has a surface shape corresponding to a predetermined shape of one surface of the lens to be produced (see figure 4). The surface shape conforms to (i.e. is similar to), but is not identical to, the shape of the predetermined base member in that the shape of the surface layer conforms with the shape of the base surface layer over a along the upper portion of the surface layer (see figure 2).

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Ishihara discloses that the surface layer is a thermoplastic film (column 5, line 36) molded to the base member (see figure 3). A thermoplastic film must inherently be formed of resin, and thus, the surface layer of Ishihara constitutes a "resin-molded surface layer."

Ishihara further discloses the surface layer to be in the range of 0.1-10 mm (column 6, lines 22-23), thereby anticipating the range of approximately 0.2 mm to approximately 0.5 mm recited in claims 30-31. This thickness is less than the thickness of the base member as is evident from Ishihara's figure 2.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 23, 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishihara in view of Inoue et al. (U.S. Pat. No. 5,759,457).

Ishihara discloses the apparatus as described above. Ishihara does not disclose the resin molded surface layer forming the lens as having an aspherical surface configuration.

Inoue discloses a lens molding die, including a surface layer (2) the molds a surface of the lens. The surface is aspherical for the purpose of molding an aspherical optical element (column 4, line 47 - column 5, line 14).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Ishihara as such to have made the resin molded surface layer portion which molds the lens product have a aspherical surface configuration because this would allow for a aspherical lens product to be molded as suggested by Inoue.

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10. Applicant's arguments filed July 11, 2003 have been fully considered but they are not persuasive.

Applicant argues that the Blum reference fails to teach or suggest the surface shape of the resin-molded surface layer conforming to, but not identical to the predetermined shape of the member or the base member surface configuration as recited in claims 1 and 21 respectively. Applicant further argues that Blum does not teach or suggest the aspherical surface of the resin-molded surface layer conforming but not identical to the spherical surface of the base member as recited in claim 23. Applicant asserts that while the surface shape of the molded layer (15) is different from that of the base member (10), the surface shape of the mold layer does not correspond to the surface shape of the base member but rather corresponds to the surface shape of the casting member.

The claims of the instant application specifically recite that the surface layer is not identical to either the shape of the base member or the surface configuration of the base member. Further, in the response, Applicant states the "conforms to" means "is similar to" (response, p. 7, line 10). Defining "conforming to" as such, the configuration of Blum's resin molded layer anticipates this language. As shown in figure 1 of Blum, the surface of the resin molded layer is "similar to" the

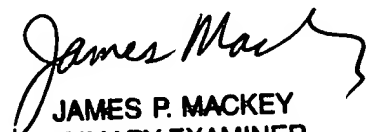
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shape of the surface of the base member - the surface of the resin molded surface layer is generally concave, as is the surface of the base member. Thus, while the surface of the resin molded layer has a notch at a central point in it, it still is "similar to" the shape of the base member surface, and therefore "corresponds" to the shape of the base member.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The unofficial fax phone number is (703) 305-3602.


Donald Heckenberg
August 20, 2003


JAMES P. MACKEY
PRIMARY EXAMINER
8/22/03